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10/042,686

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David J. Luneau

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EXAMINER

NGUYEN, LEE

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,686

Applicant(s)

LUNEAU, DAVID J.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the communication filed 3/22/2004.

Response to Amendment

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn according to the Appeal Conference.

Double Patenting

3. Applicant will file a terminal disclaimer upon receipt of a notice of allowability as shown in the remarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-51, 54 and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Regarding claims 18, 42, the claims recite “the voice signals are processed by the called telephone to produce audio using an audio transducer at the called station” and “the audio announcing circuit operatively connected to the processing unit to receive identity information therefrom, the audio announcing circuit being operative to use the identity information to produce audio using the audio transducer at the called station”. In other words, independent claims 18 and 42 require that the audio announce circuit 30 (fig. 1 of the present application) performs both processing voice signals of the caller and the producing of audio using the audio transducer of the identity information at the called station. After reviewing the content of the present application, specifically in figure 1, numeral 30, there is nowhere in the disclosure that describes such performance. Therefore, this limitation was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Dependent claims 19-41, 43-51, 54 and 59 are rejected for the same reason.

7. Claims 18-51, 54 and 59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 18 and 42, the audio announcement circuit 30 (fig. 1) of the present invention is designed to operate to produce audio using the audio transducer of the identity information at the called station. It is not designed to also process voice signals of the caller as disclosed in the specification. Therefore, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Dependent claims 19-41, 43-51, 54 and 59 are rejected for the same reason.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 52-55, 57-60, 62-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Lim (US 5,265,145) submitted by Applicant.

Regarding claim 52, Lim teaches a caller announcement apparatus (fig. 1) for a telephone system that provisions a telephone call between a caller telephone at a caller station and a called telephone at a called station, where the caller station is associated with an identity (col. 3, line 7), where the telephone system provides signals

to the called station that include caller identification signals, the caller announcement apparatus comprising:

a signal receiver 5, 6 at the called station operatively connected to the telephone system to receive signals therefrom, the signal receiver being operative to extract caller identification signals from the signals received from the telephone system and to provide caller identification data corresponding to the extracted caller identification signals (col. 2, line 34); memory storage 13 (voice recording/reproducing IC) for storing audio identity information associated with the caller identification data stored in RAM ; a processing unit 8 operatively connected to the signal receiver to receive caller identification data therefrom, the processing unit being operative to access the memory storage to retrieve stored audio identity information associated with the caller identification data (col. 2, lines 45-51); an audio announcing circuit 16 operatively connected to the processing unit 8 to receive identity information therefrom, the audio announcing circuit being operative to use the retrieved identity information to produce audio using the audio transducer (col. 2, lines 41-45).

Regarding claims 57, 62-63, the method claims are interpreted and rejected for the same reason as set forth in the apparatus claim 18.

Regarding claim 52, the claim is interpreted and rejected for the same reason as set forth in claim 18. Lim also teaches audio transducer 15 (fig. 1).

Regarding claims 53, 58, Lim also teaches that the telephone includes the transducer 15 (fig. 1).

Regarding claims 55, 60, Lim also teaches for storing the name of the caller (col. 3, line 7).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 56, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Figa et al. (US 4,924,496).

Regarding claims 56, 61, Lim does not explicitly teach that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station. Figa teaches that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station (fig. 2, numeral 34, area code 617). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Figa to the apparatus of Lim in order to provide the user with the area code of the caller.

Response to Arguments

12. Applicant's arguments with respect to claims 18-51 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments concerning the rejection of claims 52-63 have been fully considered but they are not persuasive.

With regard to the Group II claims, they recite the feature of storing "audio information associated with the caller identification data" (claim 52), "audio identity information associated with the caller identification data" (claim 57), and "audio information associated with the nonvoice alphanumeric information" (claim 62). Lim, on the other hand, contemplates only the storage of digital text information, not audio information, and thus does not anticipate any of these claims. Applicant does not dispute that Lim discloses storage of certain information in RAM 10. (2:40.) It is also true that Lim mentions a "speech synthesizer or voice recording/reproducer 13." (2:37-38.) On this specific feature of the design, Lim does not provide sufficient information to determine what item 13 is, stating only that they "are all commercially available ICs." (2:57-58.) The question, therefore, is what Lim stores in his RAM 10. Applicant submits that Lim only contemplates the storage of digital text information, not audio information, and that the digital text information is then used by item 13 to produce an audio announcement. This conclusion is compelled by Lim's statement that "[a] list of numbers and names, along with special codes appended to the numbers and names,

can be typed and stored into memory (data RAM 10) using the keyboard 7." (4:4-7.) Clearly this passage describes the storage of digital text information in RAM 10. Lim also states that "[i]f there is a number which is the same as the received number, the microprocessor 8 will access the name associated with the number and instruct the speak synthesizer or voice reproducer to spell or speak the name and show the name in the display 9." (2:41-45.) Lim further states:

The speech synthesizer IC and voice recorder/reproducer IC are all commercially available ICs. When a call comes in, speaking is better than spelling the caller's name. However, in the near future, the facility for spelling a caller's name is much more economical than speaking the name. (2:57-62.)

In order to spell the name, the individual letters that make up the name must, applicant submits, be stored as digital text information, not audio information as in the Group II claims. With regard to speaking the name, given Lim's suggestion that the technology for speaking a name is more advanced than the technology for spelling a name, Applicant submits


that this is clearly referring to some sort of (undisclosed) speech synthesis technology, that converts digital text information to audio information, which again is fundamentally different than the approach claimed in Applicant's Group II claims of storing and retrieving audio information.

In response, the examiner disagrees. The typing and storing into memory (data RAM 10) using the keyboard as argued is used for the speech synthesizer. In contrast, the voice recording/reproducing unit inherently defines itself as an audio recording unit as one having skilled in the art could recognize.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 2/9/04
LEE NGUYEN
Primary Examiner
Art Unit 2682